



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/915,659 08/21/97 O'BRIEN

T D6020

BENJAMIN ADLER  
MCGREGOR & ADLER  
8011 CANDLE LANE  
HOUSTON TX 77071

HM12/0818

EXAMINER

BUGAISKY, G

ART UNIT

PAPER NUMBER

1653

16

DATE MAILED:

08/18/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**08/915,659**

Applicant(s)  
**O'Brien et al.**

Examiner  
**Gabriele E. Bugaisky**

Group Art Unit  
**1653**



☒ Responsive to communication(s) filed on 6/15/99 and 6/28/99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 4-9, and 11 is/are pending in the application.

Of the above, claim(s) 9 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 4-8, and 11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1653

### **DETAILED ACTION**

The finality of the rejection of the previous Office action is withdrawn, upon further consideration.

The amendment of 6/18/99 and 6/28/99 are acknowledged. Claims 2 and 10 have been canceled; claim 10 remains withdrawn from consideration. Claims 1, 4-9 and 11 remain pending.

### ***Drawings***

Applicants are reminded that the drawings remain objected to, as detailed in the PTO-948 which accompanied paper no. 9.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 and 11 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for isolated DNA fragments comprising the recited DNAs, does not reasonably provide enablement for DNA comprising the recited DNAs of claim 1. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. The claims currently read upon chromosomal DNA; Applicants have not enabled the DNA of an entire chromosome. It is suggested that the claims be amended to recite isolated and purified DNA

Art Unit: 1653

fragments consisting of the recited DNAs, or isolated DNA fragments comprising the recited DNAs. Alternatively, section a) of claim 1, may, for example, be amended to recite DNA consisting of SEQ ID NO:6, along with an appropriate amendment to section b. the term "has" is interpreted as open language and is interchangeable with "comprising". It is regretted that this issue was not addressed earlier in prosecution.

The rejection of claims 1, 4, 6-8 and 11 under 35 U.S.C. §112, first paragraph, for scope of enablement regarding hybridization conditions is withdrawn, based upon the amendment.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4-8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites "A vector . . . and regulatory elements". This is deemed indefinite because it is not clear whether the claim is directed to a composition comprising the vector and regulatory elements or whether it is directed to a vector that comprises the recited regulatory elements.

With respect to claim 11, it is noted that there are two ambiguities in the claim. First, it is not clear what is encompassed by the term "corresponds to". Is it a probe that comprises specific nucleotides of SEQ ID NO:6, or is it a smaller fragment? With respect to "open reading frame," it is suggested that Applicants indicate which open reading frame. There are 3 reading

Art Unit: 1653

frames in SEQ ID NO:6, for example, and although only one frame encodes SEQ ID NO:7, there are open reading regions in each of the three frames.

Claims 5-8 are included in this rejection as they depend from claim 4 and do not clarify the ambiguity.

The rejection of claims 1, 4, 6-8 and 11 under 35 U.S.C. §112, second paragraph, or recitation of sequence identity is withdrawn, based upon the amendment.

### **Conclusion**


No claims are allowed.

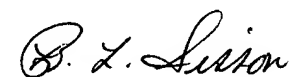
Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Gabriele E. Bugaisky, Ph.D. whose telephone number is (703) 308-4201. The Examiner can normally be reached from 7:30 AM to 4:00 PM on weekdays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bradley L. Sisson, can be reached at (703) 308-3978.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Fax Center number is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center receptionist whose telephone number is (703) 308-0196.

  
August 13, 1999

  
BRADLEY SISSON  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600  
8/16/99